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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/811,744 | 03/29/2004 | Rodney G. Powers | 19703-16483 | 1693 |

38642 7590 12/15/2004

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| EXAMINER |
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RAEVIS, ROBERT R

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| ART UNIT | PAPER NUMBER |
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2856

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/811,744

Applicant(s)

POWERS ET AL.

Examiner

Robert R. Raevis

Art Unit

2856

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 13-15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 5-12 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

This application contains claims directed to the following patentably distinct species of the claimed invention: either Figure 1 or Figure 12.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is deemed to be generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

On Dec 1, 2004, Applicant (Mr. Horton) elected Figure 12 with traverse.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "adjustment" (claims 5,6) corresponding to the "set screw and corresponding series of detents" (col. 20, lines 10-11) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The disclosure is objected to because of the following informalities: the top of the first page should refer to both the parent, and it's status.

Appropriate correction is required.

Claims 1,3,2,4,13-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 13, "conventional" (line 8) is what manner? What does the "conventional flexible means" (line 8) exactly correspond to in the written-specification/drawings? (This is necessary to compare prior art to determine equivalence with what is in the written-specification/drawings.) The "arm" (line 12) does not "elastically" (line 12) move, and thus this limitation is not consistent with the written-specification/drawings for elected Figure 12. (Note that arm 50 of non-elected Figure 1 elastically moves, but not the arm of elected Figure 12, and that Applicant is mixing structural limitations from two distinct embodiments.)

As to claim 15, is the "means for mounting" (line 1) really the same as claim 13's "conventional flexible means"? This is not likely, as the "flexible" (claim 13) relates to the spring 114, while the "adjustment" (claim 15) relates to "set screw and corresponding series of detents" (col. 20, lines 10-11). What does the "means for mounting...for the adjustment..different sizes of said pipeline" (claim 15) exactly correspond to in the written-specification/drawings? (This is necessary to compare prior art to determine equivalence with what is in the written-specification/drawings.)

As to claim 1, what exact structure in the written specification (and drawings) does the "conventional flexible means" correspond to? (In a search of prior art, it is the equivalents to the structure that must be searched, and not just any "conventional

Art Unit: 2856

flexible" item.) Also, "conventional" (line 8) in what manner? Finally, the "reflector" (line 6 from last) is not connected to any of the remaining structure, and thus the "device" (line 1) appears to be an aggregation of parts. The "arm" (line 12) does not "elastically" (line 12) move, and thus this limitation is not consistent with the written-specification/drawings for elected Figure 12. (Note that arm 50 of non-elected Figure 1 elastically moves, but not the arm of elected Figure 12, and that Applicant is mixing structural limitations from two distinct embodiments.) The "reflector" and "occluding device" are not connected to the base and arm, and thus this claim is directed to an aggregation of parts. In addition, the "occluding device" (line 4 from last) which "occludes said reflector, thereby indicating to said user that a reduction in said vertical diameter of said pipeline has been encountered" is not consistent with elected Figure 1, as the indicators in elected Figure 12 are the reflectors (Figure 17B) which provide indicators when they are made viewable.

As to claim 5, what exact structure in the written specification (and drawings) does the "means for mounting" (line 1) correspond to? Also, "said means for mounting said vertical test arm" lacks antecedent basis. Is the "means for mounting" (line 1) really the same as claim 1's "conventional flexible means"? This is not likely, as the "flexible" (claim 1) relates to the spring 114, while the "adjustment" (claim 5) relates to "set screw and corresponding series of detents" (col. 20, lines 10-11). What does the "means for mounting...for the adjustment..different sizes of said pipeline" (claim 15) exactly correspond to in the written-specification/drawings? (This is necessary to compare prior art to determine equivalence with what is in the written-specification/drawings.)

As to claim 7, what exact structure in the written specification (and drawings) does the "conventional flexible means" (line 3) correspond to? Also, "conventional" (line 3) in what manner? Also, the "second reflector" is not connected to any of the remaining structure, and thus the "device" (line 1) appears to be an aggregation of parts.

As to claim 11, what exact structure in the written specification (and drawings) does the "means for mounting said vertical test arm" (lines 1-2) correspond to? In addition, "said means for mounting said vertical test arm" lacks antecedent basis. Is the "means for mounting" (line 1) really the same as claim 1's "conventional flexible means"? This is not likely, as the "flexible" (claim 1) relates to the spring 114, while the "adjustment" (claim 5) relates to "set screw and corresponding series of detents" (col. 20, lines 10-11). What does the "means for mounting...for the adjustment..different sizes of said pipeline" (claim 15) exactly correspond to in the written-specification/drawings? (This is necessary to compare prior art to determine equivalence with what is in the written-specification/drawings.)

As to claim 2, see comments above regarding claim 1. In addition, the "occluding device" (line 4 from last) which "normally occludes said reflector, is not consistent with elected Figure 12, as the three reflector colors (green, yellow, red) suggest that that the occluding device does not normally occlude any one reflector. Finally, what structure in the claim defines "normally" (line 4 from last)?

As to claim 6, see comments above regarding claim 5.

As to claim 8, see comments above regarding claim 7.

Art Unit: 2856

As to claim 12, see comments above regarding claim 5.

As to claims 1,2, "said flashlight" lacks antecedent basis.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Kirschke.

Kirschke teaches a device, including: base 26, test arm 37 that flexes as the arm contacts the interior of a pipeline, reflective metal ruler 43, lights 57, occluding device 43,39 movable in relation to the reflector, the occluding device occludes the reflector as the arm moves, thereby indicating to a user that the reduction in vertical diameter of the pipeline has been encountered. Note that the claimed apparatus is limited to the structure and means-plus-functional limitations, and that the "user" and "flashlight" are not part of the claimed apparatus. Even if they were, the ruler would be visible to a user holding a flashlight.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert R. Raevis whose telephone number is 571-272-2204. The examiner can normally be reached on Monday to Friday from 6:30am to 4pm. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through

Art Unit: 2856

Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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RAEVIS